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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,271

08/06/2007

Christopher T. Harbison

WTHD-002

5936

71598

7590

09/24/2008

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EXAMINER

WHISENANT, ETHAN C

ART UNIT

PAPER NUMBER

1634

MAIL DATE

DELIVERY MODE

09/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/591,271	HARBISON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ethan Whisenant, Ph.D.	1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 AUG 06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 1-3,7,8,12,16,17,19,24,26,28,36,38,41,45-48 and 60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-3,7,8,12,17,19,24,26,28,36,38,41 and 45-48 is/are allowed.
- 6) ☐ Claim(s) 16 and 60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>25 JAN 07 and 09 JAN 08</u> .                                 | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 1634

**NON-FINAL ACTION**

1. The applicant's Preliminary Amendment filed 31 AUG 06 has been entered. Following the entry of the Preliminary Amendment, **Claim(s) 1-3, 7-8, 12, 16-17, 19, 24, 26, 28, 36, 38, 41, 45-48 and 60** is/are pending.

**SEQUENCE RULES**

2. This application complies with the sequence rules and the sequences have been entered by the Scientific and Technical Information Center.

**35 USC § 112- 2nd Paragraph**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**CLAIM REJECTIONS under 35 USC § 112- 2ND PARAGRAPH**

4. **Claim(s) 16 and 60** is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 16** is indefinite in that it is unclear what is intended by the phrase "site is less that 20 bp in length". This appears to be a simple typographical error and the phrase has for it evaluation against the prior art been read as "site is less than 20 bp in length". Please clarify.

**Claim 60** is indefinite because there is no nexus between the preamble and the claim steps. Claim 1 in its preamble direct to a method which is to accomplish a particular goal(i.e. identify two cell genotypes in which a protein of interest differentially binds to the genome of a cell). However, none of the claim steps states that this goal is accomplished. For clarity, claimed methods should recite that the purpose of the method has been attained (i.e. provide a nexus between the preamble and the claim steps).

#### **REASON FOR ALLOWANCE**

5. **Claims Claim(s) 1-3, 7-8, 12, 17, 19, 24, 26, 28, 36, 38, 41, and 45-48** are allowable over the prior art of record. Claims 1-3, 7-8, 12, 16-17, 19, 24, 26, 28, 36, 38, 41, and 45-48 are allowable over the prior art of record because none of the references of record alone teach all of the limitations recited in Claim 1. Neither does the prior art of record, in any combination, reasonably suggest the method(s) recited in independent Claim 1.

#### **ALLOWABLE SUBJECT MATTER**

6. **Claim(s) 16 and 60** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action because the prior art of record, if considered individually, do not teach, or if considered in any combination, do not reasonably suggest the method(s) recited in Claims 16 and 60.

#### **CONCLUSION**

7. **Claim(s) 1-3, 7-8, 12, 17, 19, 24, 26, 28, 36, 38, 41, and 45-48** is/are allowable while **Claim(s) 16 and 60** is/are rejected and/or objected to for the reason(s) set forth above.

Art Unit: 1634

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (571) 272-0754. The examiner can normally be reached Monday-Friday from 8:30AM - 5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached at (571) 272-0735.

The Central Fax number for the USPTO is (571) 273-8300. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).

/Ethan Whisenant/  
Primary Examiner  
Art Unit 1634

## EXAMINER SEARCH NOTES

**18 SEP 08 - ECW**

**Databases searched: USPATFULL, USPG-PUBS, JAPIO and EUROPATFULL via EAST &**

**CAplus, Medline and BIOSIS via STN**

Reviewed the parent(s), if any, and any search(es) performed therein : see the BIB data sheet

Reviewed, the search(es), if any, performed by prior examiners

Search terms:

Inventor(s) : e.g. Young R?/au

Identification

Conserved

Protein\$

genomic DNA

DNA binding site\$